

REMARKS/ARGUMENTS

Favorable reconsideration of this application in light of the above amendments and following discussion, is respectfully requested.

Claims 10-17 are pending; Claims 10 and 14 are amended; and no claims are added or canceled herewith. It is respectfully submitted that no new matter is added by this amendment.

Claims 10-17 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Pub. No. 2005/017716 to Ginter in view of U.S. Patent No. 5,408,607 to Nishikawa

However, the present independent claims now recite wherein set information of said usage details are decided by said usage conditions that include user condition and equipment condition that determines the information received by the user, as recited in Claim 10 and similarly recited in Claim 14. The features recited in the independent claims are disclosed at least at pages 13, 20-21, and 26-28 of the present specification. However, these features are not shown in the applied art.

Instead, Ginter discloses preserving VDE control over one or more portions of extracted content after various forms of usage of the portions. That is, maintain content in a securely stored form while allowing temporary on screen display of content or allowing a software program to be maintained in secure form but transient decrypt any encrypted executing portion of the program. The Office Action acknowledges that the claim features discussed above are not shown in Ginter. However, the Office Action asserts that Nishikawa makes up for this deficiency. Applicants respectfully disagree.

In particular, Nishikawa discloses a system to manage a building. As discussed in column 9 and shown in Figure 8, the building control monitor subsystem 720 receives through the interface 71, an instruction entered by an operator from the input unit 9 and transmits the instruction to the building control system 780 through the building control

interface 73. On demand from the operator, the building control monitor 720 also displays the requested information on the display unit 8 through the interface 71.

The counting service 721 calculates charges of building facilities/equipment, power, shared equipment, etc. depending on their usage conditions and prepares detailed accounts for tenants. The function support 722 manages usage conditions of the building facilities/equipment and operation of the building equipment such as maintenance and replacement hub equipment and parts.

Moreover, it is respectfully submitted that there is no basis in the teachings of either Ginter or Nishikawa to support their applied combination. Certainly, the outstanding Office Action fails to cite to any specific teachings within either reference to support the applied combination. When an obviousness determination is based on multiple prior art references, there must be a showing by the patent examiner of some "teaching, suggestion, or reason" to combine the references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the "absence of such a suggestion to combine is dispositive in an obviousness determination"). Whether motivation to combine the references is shown is a question of fact. See In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, *inter alia*, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Although a reference need not expressly teach that the disclosure contained therein should be combined with another, see Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461, 1472, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997), the showing of combinability, in whatever form, must nevertheless be "clear and particular." Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. "Trade-offs often concern what is feasible, not what is, on balance, desirable. Motivation to

combine requires the latter." Winner International Royalty Corp. v. Wang, 53 USPQ2d 1580, 1587 (Fed. Cir. 2000). Interpreting the Supreme Court's decision in Dickinson v. Zurko, 50 USPQ2d 1930 (1999) regarding the standard of review in patent matters, the CAFC determined that when upholding a rejection of a claimed invention in an appeal, the CAFC must find that the decision by the USPTO Board of Appeals and Interferences is supported by "substantial evidence," In re Gartside, 53 USPQ2d 1769 (Fed. Cir. 2000). Accordingly, for a proper rejection based on a combination of references, the rejection must be supported by evidence that the motivation to combine references was not merely feasible, but desirable.

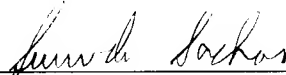
As discussed above, Nishikawa discusses usage conditions as directed to determining the status of building facilities/equipment, power, shared equipment usage. Thus, Nishikawa is concerned with a system to manage a building. There is no motivation to combine the teachings in the applied art. Accordingly, it is respectfully submitted that the combination of the applied art is the result of hindsight reconstruction in view of the teachings of the present specification, and is improper. For at least these reasons, the rejection of the claims under 35 U.S.C. § 103(a) should be withdrawn.

Consequently, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal allowance. A Notice of Allowance for Claims 10-17 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact the undersigned representative at the below-listed telephone number.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Bradley D. Lytle
Attorney of Record
Registration No. 40,073

Kevin M. McKinley
Registration No. 43,794

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

I:\ATTY\KMM\PROSECUTION WORK\285738\285738US-AM DUE 9-9-07.DOC

Surinder Sachar
Registration No. 34,423